



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,447	06/24/2003	Erik Ho Fong Wong	00054.US1	9394

25533 7590 12/01/2006

PHARMACIA & UPJOHN
7000 Portage Road
KZO-300-104
KALAMAZOO, MI 49001

EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,447

Applicant(s)

WONG, ERIK HO FONG

Examiner

Renee Claytor

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,11,12,14-31 and 33-53 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-9,11,12,14-30,33 and 36-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/3/2004, 10/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group II is hereby acknowledged.

Applicant's election of sertraline as the species is also acknowledged. Therefore, claims 31 and 34-35 are being examined on their merits herein and claims 1, 4-9, 11-12, 14-30, 33, 36-53 are withdrawn from consideration as they do not read on the elected species. The traversal is on the ground(s) that there is not a serious burden on the Examiner to search the inventions of Groups I and II. This is not found persuasive because as is stated in the Election/Restriction requirement dated on 6/15/2006, inventions are distinct if it can be shown that: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). The Examiner pointed out that the process of using the product can be accomplished with another materially different product, such as nicotine patches or gum. It is further pointed out that the product (composition) as claimed can be used in another materially different process, such as for the treatment of depression. Because the two inventions are distinct, the requirement is still deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1617

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harkin et al. (European Journal of Pharmacology 364 (1999) 123-32) in view of Wong et al. (U.S. Patent 6,465,458).

Harkin et al. teach a combination of the pharmaceutical agents reboxetine and sertraline used in a method for treating depression (meeting the limitations of claims 31 and 34-35; pg. 126, second paragraph under section 2.9).

Harkin et al. do not teach the S,S-enantiomer of reboxetine.

Wong et al. teach a pharmaceutical composition comprised of the S,S-enantiomer of reboxetine (Col. 5, lines 35-39).

Accordingly, it would be obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Harkin et al, which teaches a composition comprised of reboxetine and sertraline, with the teachings of Wong et al. which teaches the use of the S,S-enantiomer of reboxetine in a pharmaceutical composition. One would be motivated to utilize the S,S-enantiomer of reboxetine in the composition of Harkin et al. because Wong et al. teaches that the S,S-enantiomer of reboxetine does not have the adverse side effect profile associated with the racemic mixture (see Col. 6, lines 44-52).

Conclusion

No claims are allowed.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is 571-272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor



**SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER**